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In re Application of FOX et al :
U.S. Application No.: 10/584,358 :
PCT Application No.: PCT/AU2004/001820 : DECISION
Int. Filing Date: 23 December 2004 :
Priority Date Claimed: 24 December 2003 :
Attorney Docket No.: 3276-7872US :
For: A SYSTEM FOR WATER TREATMENT :

This is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.47(b)" filed 08 April 2008.

BACKGROUND

On 23 December 2004, applicant filed international application PCT/AU2004/001820, which claimed priority of an earlier Australia application filed 24 December 2003. A copy of the international application was communicated to the USPTO from the International Bureau on 07 July 2005. The thirty-month period for paying the basic national fee in the United States expired on 24 June 2006.

On 23 June 2006, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 02 March 2007, applicant filed a petition under 37 CFR 1.47(b).

On 16 May 2007, this Office mailed a decision dismissing the 02 March 2007 petition.

On 16 October 2007, applicant filed a renewed petition under 37 CFR 1.47(b).

On 08 February 2008, this Office mailed a decision dismissing the 16 October 2007 renewed petition.

On 08 April 2008, applicant filed the present second renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (3), (4), (5), and (6) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventors John Fox and Errol O'Brien refuse to sign the application papers. With regard to inventor Fox, petitioner has adequately demonstrated that a bona fide attempt was made to present a copy of the application papers (including specification, claims, drawings, and oath/declaration) to Fox for signature (see the 08 April 2008 affidavit of Nancy Johnson, ¶1-2). Petitioner has previously furnished sufficient evidence of Fox's refusal to cooperate. With respect to inventor O'Brien, the present petition adequately illustrates that a bona fide attempt was made to present a copy of the applications papers to O'Brien for signature (see 08 April 2008 affidavit of Nancy Johnson, ¶1-2). Petitioner has previously supplied sufficient evidence of O'Brien's refusal to sign. Thus, it can be concluded with reasonable certainty that inventors Fox and O'Brien refuse to join in the application.

CONCLUSION

For the reasons above, the second renewed petition under 37 CFR 1.47(b) is GRANTED.

This application has an international filing date of 23 December 2004 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 16 October 2007.

As set forth in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

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